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Paper No. 15
AD

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Financial Engines, Inc.

Serial No. 75/451,194

Lori M. Stockton of Blakely, Sokoloff, Taylor & Zafman for
Financial Engines, Inc.

Rene M. LaForte, Trademark Examining Attorney, Law Office
106 (Mary Sparrow, Managing Attorney).

Before Hanak, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On March 16, 1998, Financial Engines, Inc. (applicant)
filed Trademark Application Serial No. 75/451,194 seeking
registration of the mark FORECAST ENGINE (typed drawing)
for services ultimately identified as "interactive, on-line
financial services, namely, financial planning, investment
analysis and consultation and portfolio allocation offered
via a global computer network" in International Class 36.

Applicant alleges that it first used the mark and first used the mark in commerce on February 23, 1998.

The Examining Attorney refused to register the mark on the ground that the mark, when applied to the services, is merely descriptive. 15 U.S.C. § 1052(e)(1). After the refusal was made final, this appeal followed. Applicant and the Examining Attorney¹ have filed briefs. An oral hearing was not requested.

Because we conclude that the mark FORECAST ENGINE is merely descriptive when applied to interactive, on-line financial services, namely, financial planning, investment analysis and consultation and portfolio allocation offered via a global computer network, we affirm the Examining Attorney's refusal to register applicant's mark.

The Examining Attorney's position is that the mark "immediately and unequivocally describe[s] a feature of the applicant's services, to wit: providing the on-line use of software that performs the repetitive computations for calculating and estimating (i.e. forecasting) how specific financial investments might perform in the future." Brief at 6. The Examining Attorney relies on the following evidence and arguments to support her conclusion.

¹ The current Examining Attorney was not the original examining attorney.

First, the term "forecast" is defined as "to calculate or estimate something in advance." *American Heritage Dictionary of the English Language* (3rd Ed. 1992). An engine refers to "software that performs a primary and highly repetitive function such as a database engine, graphics engine or dictionary engine." Freedman, *The Computer Glossary*, (8th Ed. 1998).

Second, the Examining Attorney has submitted LEXIS/NEXIS articles that show that the terms "forecast engine" or "forecasting engine" are used "when referring to software programs and on-line services that function to project a set of outcomes based upon controlled and uncontrolled data combinations." (Brief at 6).

Based on the LEXIS/NEXIS evidence², the Examining Attorney argues the term FORECAST ENGINE is commonly used to describe software and online services that perform forecasting functions. "A key component of a forecasting engine is its ability to generate different forecasts reflecting the different 'what if' scenarios submitted by the user." Br. at 8.

Next, the Examining Attorney argues that applicant's specimens of use "feature the use of a software engine to

² We have not considered the Canadian article to which applicant objected.

forecast the financial performance of its user's financial investments" (brief at 8) as shown below:

The largest pension fund managers, who invest billions on behalf of employees, rely on "simulation technology" to manage this uncertainty. This approach generates thousands of "what if" scenarios that show how much their investments might be worth in the future.

Financial Engines brings this technology to individuals. Our Forecast Engine™ provides you with a view of how specific investments might perform in the future, including scenarios where markets perform poorly. Each scenario is based on statistical modeling of key economic indicators and how they interact.

Finally, the Examining Attorney has pointed to applicant's own press release quoted below as evidence of the descriptiveness of the term FORECAST ENGINE.

At the heart of the Advisor is the Forecast Engine™. This system forecasts the range of future retirement income likely to result from owning any combination of specific investments. . . .

State Street's trained, licensed financial advisors will use Financial Engines' simulation engines to forecast retirement outcomes for Advice Account participants.

Based on this evidence, the Examining Attorney concluded that the mark FORECAST ENGINE is merely descriptive for applicant's services.

In its brief, applicant argues that the term FORECAST ENGINE is not merely descriptive of its service and that the term "FORECAST ENGINE is a fanciful, unitary phrase

that is nebulous in meaning." Br. at 4. "Not one article demonstrates use of the wording FORECAST ENGINE in a merely descriptive manner with respect to the services identified in the instant application." Br. at 7. Applicant also argues that "a consumer must make a 'mental pause' to determine the significan[ce] of the mark as it relates to applicant's services." Id. In particular, applicant claims that "engine" most commonly refers to machinery or locomotives.

We begin our analysis by noting that a mark is merely descriptive if it immediately describes the ingredients, qualities, or characteristics of the goods or if it conveys information regarding a function, purpose, or use of the goods. In re Abcor Development Corp., 588 F.2d 811, 200 USPQ 215, 217 (CCPA 1978). A term may be descriptive even if it only describes one of the qualities or properties of the goods. In re Gyulay, 820 F.2d 1216, 1217, 3 USPQ2d 1009, 1009 (Fed. Cir. 1987). We look at the mark in relation to the goods or services, and not in the abstract, when we consider whether the mark is descriptive. Abcor, 588 F.2d at 814, 200 USPQ at 218.

Thus, we must decide whether the term FORECAST ENGINE for applicant's services describes a quality,

characteristic, ingredient, function, purpose or use of these services.

The evidence supports the Examining Attorney's determination that the term describes a function, feature or characteristic of the services. The Examining Attorney's dictionary definitions alone make it clear that applicant's term is merely descriptive. "To forecast" means to calculate or estimate something in advance. It cannot be seriously argued that applicant's services do not calculate investments in advance. "Our Forecast Engine™ provides you with a view of how specific investments might perform in the future, including scenarios where markets perform poorly. Each scenario is based on statistical modeling on key economic indicators and how they interact." Indeed, applicant's own press release states: "This system forecasts the range of future retirement income." Applicant's services calculate or forecast the potential return of an investment based on different assumptions. Therefore, the term "forecast" describes a function, feature or characteristic of the services.

The next question is whether the term "engine" is also descriptive of applicant's services. While applicant has argued that the term engine is most commonly understood to refer to machinery or a locomotive, this ignores the

requirement that we not determine descriptiveness in a vacuum, but in relation to the goods or services. The Examining Attorney has demonstrated that the term "engine" has a common meaning when it is applied to software, i.e., software that performs a primary or highly repetitive function such as a database engine, graphics engine or dictionary engine. Applicant's on-line software meets the definition of software that performs a primary or highly repetitive function.

However, a mark is not merely descriptive simply because its individual components are descriptive. We must consider whether the mark as a whole is descriptive. While the words may individually be descriptive of the goods, the mark as whole may have a non-descriptive meaning. In other words, the mark may be more than simply the sum of its parts. See In re Colonial Stores, 394 F.2d 549, 157 USPQ 382 (CCPA 1968) (phrase SUGAR & SPICE from nursery rhyme not merely descriptive for bakery products).

In this case, the evidence confirms that the mark when viewed as a whole is merely descriptive of the services. The Examining Attorney has demonstrated through NEXIS evidence (examples of which follow) that the term "forecast engine" or "forecasting engine" is a term that is commonly used to describe software.

In other words, it should have the capabilities to combine multiple off-the-shelf software applications, such as sales forecast engines and Excel spreadsheets to create an integrated solution. *Journal of Business Forecasting* (Fall 1996), p. 2-23.

What to look for in a forecasting engine . . . Does the forecast engine deliver forecasts and statistical results such as RI, model equation, an audit trail of the expert system process, and table of forecasts? Does the engine provide such output in user defined files? *Journal of Business Forecasting* (Fall 1996), p. 10-14.

Forecasting requires a significant amount of number crunching because the business rules are enormous - consider the forecast engine which produces information, often through a round robin tournament approach. In the round robin, the same data are subjected to multiple forecasting techniques, e.g. naïve extrapolation, single- double or triple exponential smoothing and e-curve. *Journal of Business Forecasting* (Summer 1995), p. 6-9.

The forecasting engine can be used to develop and assess financial as well as merchandise strategies. *Chain Store Age Executive with Shopping Center Age* (October 1997), p. S14.

". . . Once you've got that, plugging in available people is not all that difficult. That's where [software] vendors differentiate themselves - in the forecasting engine." *Supermarket News*, (March 3, 1997), p. 25.

This paper outlines a number of important issues that should be considered when acquiring or developing a "forecasting engine." Good management begins with a plan. Proper planning begins with an accurate forecast. *Journal of Business Forecasting Methods & Systems* (Fall 1996), p. 10-14.

. . . [N]eeds an advanced planning system with two features, a "world class" forecasting engine and the means to share planning information with regional offices. *Traffic World* (June 8, 1998), p. 36.

This data becomes the project's parameters fed into ForeSight's forecasting engines. *InternetWeek* (April 20, 1998), p. 46.

What you want is an electronic tool and infrastructure to calculate when you can ship, and you need a forecasting engine to compensate for product constraint. *Computer Reseller News* (March 2, 1998).

PowerPlay to get forecasting engine. *PC Week* (December 11, 1998), p. 49.

Applicant responded to this evidence by pointing out that no article refers to financial services. However, there is no requirement that the Examining Attorney provide an article showing a descriptive use of applicant's exact mark on its specific services. Even if applicant is the only entity using the term, it does not compel a conclusion that the mark is not merely descriptive. See In re Helena Rubinstein, Inc., 410 F.2d 438, 441, 161 USPQ 606, 609 (CCPA 1969) ("Applicant's long use of the wording, and the fact that others have not used it up to this time, does not make it any less an apt description for the goods"); In MBAssociates, 180 USPQ 338, 339 (TTAB 1973) (Whether a term is unique or ordinarily used to describe a feature is not a controlling factor). It is particularly unnecessary in a case such as this where applicant's own press release refers to its services as: "State Street's trained, licensed financial advisors will use Financial Engines' simulation engines to forecast retirement outcomes." The

press release shows that applicant uses an engine to forecast retirement and investment scenarios. Clearly, the evidence shows that the mark informs purchasers of a function, feature, or characteristic of the services. Applicant's combined term results in no ambiguity, and the mark is, therefore, descriptive of the services.

Finally, applicant argues that the Office's treatment of some prior registrations and applications justifies the reversal of the Examining Attorney's refusal. These registrations and applications do not persuade us that the Examining Attorney's refusal should be reversed. First, the mere fact that an applicant can point to five registrations involving different marks containing the word "engine" hardly demonstrates that the Board should ignore the evidence of descriptiveness in this case. See In re Nett Designs, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) ("Even if some registrations had some characteristics similar to Nett Designs' application, the PTO's allowance of such prior registrations does not bind the Board or this court"). Each case must be decided on its own merits and we do not have the files of those cases in front of us to explain why those marks issued.

Second, applicant also refers to two of its applications for the identical mark FORECAST ENGINE, which

have been not been finally refused registration. However, the goods and services in those applications are not the same as the services in this application. Even if they were relevant, the evidence of descriptiveness should not be ignored.

Finally, we note that applicant has failed to mention another pending application it owns for the mark FORECAST ENGINE for computer software for financial planning, investment analysis, portfolio allocation and recommendations for selecting specific financial instruments. That application (Serial No. 75/461,553) has been finally refused registration by the Examining Attorney and a decision will issue concurrently with this decision.

Decision: The refusal to register on the ground that the mark FORECAST ENGINE is merely descriptive of the involved services is affirmed.